

REMARKS

The Examiner has requested that applicant submit a marked up copy for all continuation-in-part applications to which applicant has claimed priority in order to show the subject matter added. Applicant respectfully asserts that such a marked up copy is submitted herewith.

The Examiner has rejected Claim 30 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is moot in view of the cancellation of the claim.

The Examiner has rejected Claims 16 and 29 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully asserts that such rejection is avoided in view of the clarifications made hereinabove to Claims 16 and 29.

The Examiner has rejected Claim 30 under 35 U.S.C. 101 as being directed towards non-statutory subject matter. This rejection is moot in view of the cancellation of the claim.

The Examiner has rejected Claims 1, 2, 5, 11, 12, 17, 22, 23, 28, 30, and 56-58 under 35 U.S.C. 102(e) as being anticipated by Pace et al. (U.S. Patent No. 6,460,050). Applicant respectfully disagrees with such rejection, especially in view of the amendments made hereinabove to independent Claim 1.

Specifically, applicant has incorporated the following language in independent Claim 1 to further distinguish applicant's claim language from the Pace reference:

“processing the e-mail messages by removing HTML comments and HTML tags from the e-mail messages.”

Applicant respectfully asserts that Pace teaches “[a] file content classification system includes a digital ID generator and an ID appearance database coupled to receive IDs from the ID generator” where “a digital identifier for the data file [is generated]” and it is determined “whether the... identifier matches a characteristic of other identifiers” such that “the data file [is processed] based on said step of determination” (Abstract). However, merely teaching that a digital identifier for a data file is generated and that it is determined whether the identifier matches a characteristic of another identifier, as in Pace, simply fails to even suggest “processing the e-mail messages by removing HTML comments and HTML tags from the e-mail messages” (emphasis added), as currently claimed by applicant.

Further, applicant has amended independent Claim 1 to read as follows:

“generating hash values, as generated hash values, based on a plurality of portions of each message body of the plurality of e-mail messages that have been processed by removing the HTML comments and the HTML tags, such that each message body of each of the e-mail messages has a corresponding plurality of generated hash values” (emphasis added).

Applicant respectfully points out that the Examiner has relied on Col. 4, lines 1-14 from Pace to meet applicant’s claimed “generating hash values.” However, applicant asserts that such excerpt from Pace teaches that “the digital ID generated may be one hash, or multiple hashes, and the hashing algorithm may be performed on all or some portion of the data under consideration” (Col. 4, lines 7-10 – emphasis added). Merely teaching that the hashing algorithm may be performed on all or some portion of the data under consideration, as in Pace, fails to suggest applicant’s claimed “generating hash values, as generated hash values, based on a plurality of portions of each message body of the plurality of e-mail messages that have been processed by removing the HTML

comments and the HTML tags, such that each message body of each of the e-mail messages has a corresponding plurality of generated hash values" (emphasis added), as claimed by applicant.

Further, applicant has amended independent Claim 1 to read as follows:

"counting a number of the generated hash values corresponding to the message body associated with one of the plurality of e-mail messages that match the hash values corresponding to the message body associated with prior e-mail messages; and

utilizing a settable score-related threshold, determining that one of the plurality of e-mail messages is a potentially unwanted e-mail message, the determination being based, at least in part, on the number of the generated hash values corresponding to the message body associated with one of the e-mail messages that match the hash values corresponding to the message body associated with the prior e-mail messages" (emphasis added).

Applicant respectfully asserts that Pace teaches that "[i]n one embodiment, where spam determination is the goal, the algorithm computes, for example, the frequency with which a message (or, in actuality, the ID for the message), is received within a particular time frame... [and that f]or example, if a particular ID indicating the same message is seen some number of times per hour, the system classifies the message (and ID) as spam" (Col. 6, lines 2-8 – emphasis added).

However, merely computing the frequency with which the ID for a message is received within a particular time frame and classifying the message as spam if the same message is seen some number of times per hour, as in Pace, simply fails to teach or suggest applicant's claimed "counting a number of the generated hash values corresponding to the message body associated with one of the plurality of e-mail messages that match the hash values corresponding to the message body associated with prior e-mail messages; and utilizing a settable score-related threshold, determining that

one of the plurality of e-mail messages is a potentially unwanted e-mail message, the determination being based, at least in part, on the number of the generated hash values corresponding to the message body associated with one of the e-mail messages that match the hash values corresponding to the message body associated with the prior e-mail messages” (emphasis added), especially where the “hash values [are generated], as generated hash values, based on a plurality of portions of each message body of the plurality of e-mail messages that have been processed by removing the HTML comments and the HTML tags, such that each message body of each of the e-mail messages has a corresponding plurality of generated hash values” (emphasis added), in the context claimed.

Applicant respectfully asserts that by virtue of the above features incorporated into independent Claim 1, unwanted e-mail messages may be more effectively identified in situations where third parties attempt to circumvent the system.

The Examiner is reminded that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, the identical invention must be shown in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

This criterion has simply not been met by the above reference excerpt(s), as noted above. Thus, a notice of allowance or a proper prior art showing of all of applicant’s claim limitations, in combination with the remaining claim elements, is respectfully requested.

Applicant further notes that the prior art is also deficient with respect to the dependent claims. For example, respect to Claim 22, the Examiner has relied on Col. 6, lines 18-34 (excerpted below) from the Pace reference to make a prior art showing of

applicant's claimed "passing the plurality of e-mail messages without further examination when the generated hash values match one or more of the known legitimate mailing lists."

"It should be recognized that in certain cases, large reputable companies forward a large block of e-mails to a widespread number of users, such as, for example information mailing list servers specifically requested by e-mail receivers. The system accounts for such mailing list application on both the area and second tier system levels. Exceptions may be made in the algorithm running on the third tier database 220 to take into account the fact that reputable servers should be allowed to send a large number of e-mails to a large number of recipients at the destination system 20'. Alternatively, or in conjunction with such exceptions, users may define their own exceptions via the DS10 configuration. As a service, any number of acceptable sources such as, for example, the Fortune 1000 companies' domain names may be characterized as exempted 'no spam' sites, and users can choose to 'trust' or 'not trust' server side settings." (Col. 6, lines 18-34 - emphasis added)

Applicant respectfully asserts that the excerpt relied upon by the Examiner merely discloses that "[e]xceptions may be made in the algorithm running on the third tier database 220 to take into account the fact that reputable servers should be allowed to send a large number of e-mails to a large number of recipients at the destination system 20" (emphasis added), and that "domain names may be characterized as exempted 'no spam' sites, and users can choose to 'trust' or 'not trust' server side settings" (emphasis added).

First, merely disclosing that reputable servers should be allowed to send a large number of e-mails to a large number of recipients and that domain names may be characterized as exempted "no spam" sites, as in Pace, simply fails to teach or suggest applicant's claimed "passing the plurality of e-mail messages without further examination when the generated hash values match one or more of the known legitimate mailing lists" (emphasis added), as claimed by applicant. Clearly, the mere characterization of domain names as exempted "no spam" sites, as in Pace, simply fails to even suggest "passing the plurality of e-mail messages without further examination when the generated hash values match one or more of the known legitimate mailing lists" (emphasis added), as claimed by applicant.

Second, users choosing to “trust” or “not trust” server side settings, as in Pace, simply fails to teach or suggest applicant’s claimed “passing the plurality of e-mail messages without further examination when the generated hash values match one or more of the known legitimate mailing lists” (emphasis added), as claimed by applicant.

With respect to Claim 15 et al., the Examiner has rejected the same under 35 U.S.C. 103(a) as being unpatentable over Pace, in view of Bandini (U.S. Patent Publication No. 2002/0199095). Specifically, the Examiner has relied on Col. 6, lines 1-18 from the Pace reference to make a prior art showing of applicant’s claimed “determining a first suspicion count based on a number of the hash values associated with the prior e-mail messages that match the one or more first hash values, and determining a second suspicion count based on a number of the hash values associated with the prior e-mail messages that match the second hash value.”

Applicant respectfully asserts that Pace teaches that “[i]n one embodiment, where spam determination is the goal, the algorithm computes, for example, the frequency with which a message (or, in actuality, the ID for the message), is received within a particular time frame... [and that f]or example, if a particular ID indicating the same message is seen some number of times per hour, the system classifies the message (and ID) as spam” (Col. 6, lines 2-8 – emphasis added).

However, merely computing the frequency with which the ID for a message is received within a particular time frame and classifying the message as spam if the same message is seen some number of times per hour, as in Pace, simply fails to teach or suggest applicant’s claimed “determining a first suspicion count based on a number of the hash values associated with the prior e-mail messages that match the one or more first hash values, and determining a second suspicion count based on a number of the hash values associated with the prior e-mail messages that match the second hash value” (emphasis added), where the “hash values [are generated], as generated hash values, based on a plurality of portions of each message body of the plurality of e-mail messages

that have been processed by removing the HTML comments and the HTML tags, such that each message body of each of the e-mail messages has a corresponding plurality of generated hash values” (see independent Claim 1 for context - emphasis added), in the context claimed.

Further, with respect to Claim 18, the Examiner has also rejected the same under 35 U.S.C. 103(a) as being unpatentable over Pace, in view of Bandini. Specifically, the Examiner has relied on Col. 5, lines 41-54 (excerpted above) from the Pace reference to make a prior art showing of applicant’s claimed “determining whether a newly received e-mail message exceeds a mail quota, identifying an earlier-received e-mail message with a highest suspicion score, determining whether the suspicion score of the newly received e-mail message is lower than the suspicion score of the earlier-received e-mail message when the newly received e-mail message exceeds the mail quota, deleting the earlier-received e-mail message when the suspicion score of the newly received e-mail message is lower than the suspicion score of the earlier-received e-mail message, and storing the newly received e-mail message.” Specifically, the Examiner has argued that the “subject line may be appended to indicate that the e-mail is ‘spam.’”

Applicant respectfully asserts that the excerpt from the Pace reference relied upon by the Examiner merely teaches that “in addition to deleting spam e-mail, the subject line may be appended to indicate that the e-mail is ‘spam,’ the e-mail may be held in a quarantine zone for some period of time, an auto reply generated, and the like” (Col. 5, lines 44-48 – emphasis added).

However, merely appending the subject line to indicate that the e-mail is “spam,” as in Pace, simply fails to teach or suggest applicant’s claimed “determining whether a newly received e-mail message exceeds a mail quota, identifying an earlier-received e-mail message with a highest suspicion score, determining whether the suspicion score of the newly received e-mail message is lower than the suspicion score of the earlier-received e-mail message when the newly received e-mail message exceeds the mail quota, deleting the earlier-received e-mail message when the suspicion score of the newly

received e-mail message is lower than the suspicion score of the earlier-received e-mail message, and storing the newly received e-mail message” (emphasis added), as claimed by applicant.

With respect to Claim 16 et al., the Examiner has rejected the same under 35 U.S.C. 35 103(a) as being unpatentable over Pace, in view of Bandini, and further in view of Bates (U.S. Patent No. 6,985,923). Specifically, the Examiner has relied on Col. 1, lines 22-30 (excerpted below) from the Bates reference to make a prior art showing of applicant’s claimed “determining that the one of the plurality of e-mail messages is a potentially unwanted email message when the first suspicion count is higher than the second suspicion count” (as currently amended). Specifically, the Examiner has argued that “Bates teaches determining that a message is unwanted when the same message is received from different senders.”

“One problem associated with the utilization of forwarded messages is that a particular user or recipient may repeatedly receive the same e-mail message from different senders. The recipient may eventually become cluttered with redundant e-mail messages or become annoyed with reading or receiving these redundant e-mail messages.

Therefore, a need exists for a method, article of manufacture and apparatus for processing redundant e-mail messages.” (Col. 1, lines 22-30 - emphasis added)

Applicant respectfully asserts that the excerpt from the Bates reference relied upon by the Examiner merely teaches that “a need exists for a method, article of manufacture and apparatus for processing redundant e-mail messages” (emphasis added). However, merely disclosing that a need exists for processing redundant e-mail messages, as in Bates, simply fails to teach or suggest applicant’s claimed “determining that the one of the plurality of e-mail messages is a potentially unwanted email message when the first suspicion count is higher than the second suspicion count” (emphasis added), as claimed by applicant.

With respect to the rejection under 35 U.S.C. 102(e), the foregoing anticipation criterion has simply not been met by the above reference excerpt(s), as noted above.

With respect to the rejection under 35 U.S.C. 103(a), to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

To this end, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Still yet, applicant brings to the Examiner's attention the subject matter of new Claims 67-69 (below), in addition to new Claims sets 70-101 and 102-133 which are each analogous to Claims 1-69 above, which are added for full consideration:

“wherein the processing the e-mail messages by removing the HTML comments and the HTML tags from the e-mail messages occurs before the generating the hash values” (see Claim 67);

“wherein the processing the e-mail messages by removing the HTML comments and the HTML tags from the e-mail messages occurs in parallel with the generating the hash values” (see Claim 68); and

“wherein the portions of each message body of the plurality of e-mail messages that have been processed by removing the HTML comments and the HTML tags include blocks” (see Claim 69).

Again, a notice of allowance or a proper prior art showing of all of applicant’s claim limitations, in combination with the remaining claim elements, is respectfully requested.

Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-4964 (Order No. SVIPGP085).

Respectfully submitted,
Stragent, LLC

/Christopher M. Edgeworth/

Christopher M. Edgeworth
Registration No. 60,193

211 West Tyler St.
Suite C
Longview, TX 75601
(903) 230-9676